

M. E.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Del Laboratories, Inc. : BEFORE THE
Trademark: N.Y.C. NEW YORK EYEWEAR : TRADEMARK TRIAL
Serial No: 75/778612 : AND
Attorney: David B. Kirschstein : APPEAL BOARD
Address: 489 Fifth Avenue : ON APPEAL
New York, NY

SEP 20 2002

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark "N.Y.C. NEW YORK EYEWEAR" for "eyewear, namely, sunglasses, eyeglasses, frames, lenses, eyeglass cases and eyeglass cords" on the grounds that the mark is primarily geographically descriptive under Trademark Act Section 2(e)(2).

I. FACTS

The applicant applied for registration of the trademark "N.Y.C. NEW YORK EYEWEAR" for "eyewear, namely, sunglasses, eyeglasses, frames, lenses, eyeglass cases and eyeglass cords." Registration was refused under Trademark Act Section 2(e)(2), 15 U.S.C. Section 1052(e)(2), because the mark is primarily geographically descriptive. This appeal follows the examining attorney's continuing final refusal on this issue.

II. ARGUMENT

THE MARK OF THE APPLICANT IS THE NAME OF A PLACE KNOWN TO THE PUBLIC AND THE PUBLIC WOULD BELIEVE THAT THE GOODS FOR WHICH THE MARK IS SOUGHT TO BE REGISTERED ARE MANUFACTURED, PRODUCED OR ORIGINATE IN THE PLACE SUCH THAT THE MARK IS PRIMARILY GEOGRAPHICALLY DESCRIPTIVE OF THE GOODS.

The Court in *In re California Pizza Kitchen* 10 USPQ 1704 at 1705 (TTAB 1989), listed the principal factors to be considered in determining whether a mark is primarily geographically descriptive. The following factors determine the geographical descriptiveness of a mark: if the primary significance of a mark is to indicate a geographic location which is neither obscure nor remote, and if the applicant's goods are manufactured, produced or originate, at least in part, in the location indicated, then the public is likely to believe that the geographic term identifies the place from which the goods originate. *In re Chalk's International Airlines, Inc.*, 21 USPQ2d 1637 (TTAB 1991).

The addition of a generic or highly descriptive term to a geographic term does not obviate a determination of geographic descriptiveness. *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986); *In re Cambridge Digital Systems*, 1 USPQ2d 1659 (TTAB 1986). Accordingly, the addition of the term EYEWEAR does not avoid the refusal.

A. THE PRIMARY SIGNIFICANCE OF A MARK IS TO INDICATE A GEOGRAPHIC LOCATION WHICH IS KNOWN TO THE PUBLIC AND IS NEITHER OBSCURE NOR REMOTE

The primary significance of the terms "N.Y.C." and "NEW YORK" are geographic. Attached to the first Office action are copies of entries taken from The American Heritage Dictionary showing "N.Y.C." as "*abbreviation* New York City"¹ and "NEW YORK" as "a state of the northeast United States.; Or **New York City**. A city of southern New York on New York Bay at the mouth of the Hudson River."² The Board has stated that "if a geographic term in a mark is neither remote nor obscure and the geographic significance is the primary connotation of the term, and where the goods and services actually originate from the geographic place designated in the mark, a public association *may ordinarily be presumed*." *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998), *citing*, *California Pizza Kitchens, Inc.*, 10 USPQ2d 1704, 1705 (TTAB 1989). In this case, the geographic term is not remote, nor obscure, the primary term in the mark is "NYC," and the applicant's address is shown to be Uniondale, New York. "Uniondale" is defined as "an unincorporated settlement, Nassau Co., SE New York, on Long Island." Merriam Webster's Geographical Dictionary 1219 (1997). Uniondale is geographically close to New York City and is located in the state of New York, thus, the public association between the goods and NYC, may be presumed.

Additionally, the applicant has conceded that the terms "N.Y.C. NEW YORK" are descriptive. The applicant disclaimed the terms "N.Y.C." and "NEW YORK" in its response to the first Office action received September 19, 2000.

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In the present case, the impression created by the terms "N.Y.C. NEW YORK" is geographic. The terms "N.Y.C. NEW YORK" have no other meaning than geographic. The terms are found in a dictionary, rendering them neither remote nor obscure. Thus, the terms N.Y.C. and NEW YORK are primarily geographically descriptive.

B. THE PUBLIC IS LIKELY TO BELIEVE THAT THE GEOGRAPHIC TERM IDENTIFIES THE PLACE FROM WHICH THE GOODS ORIGINATE

Where there is no genuine issue that the geographic significance of the term is its primary significance and where the geographic place is neither obscure or remote, a public association of the goods with the place named in the mark may ordinarily be presumed from the fact that applicant's own goods or services come from that place. *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704,1705 (TTAB 1988) and *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982).

The applicant has disclaimed "N.Y.C." and "NEW YORK," thus, the applicant has conceded the public association between the goods and New York City, New York. A place *need not be well known or known or noted* for the goods for a goods place association to be found. The Office only has to show that the goods/place association is reasonable so that prospective purchasers would expect that the goods are manufactured, produced or originate in the geographic place named in the mark. The examining attorney must make only a *prima facie* showing that a public association exists between the applicant's goods and "N.Y.C. NEW YORK." The examining attorney need not show the fame of the place, but rather the likelihood that the particular place will be associated with the particular goods. *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865

(Fed. Cir. 1985). Applicant is located very near New York City, New York, and intends to provide goods under the mark N.Y.C. NEW YORK EYEWEAR. Because applicant's goods come from a place near N.Y.C., NEW YORK and the applicant has conceded this by disclaiming the terms, it is likely that the public will associate the goods with the place named in the proposed mark.

As discussed earlier in this brief, the addition of a generic or highly descriptive term to a geographic term does not obviate a determination of geographic descriptiveness. The term "EYEWEAR" with regard to "eyewear, namely sunglasses eyeglasses" is highly descriptive or generic. Thus, the addition of the term EYEWEAR does not preclude the geographic descriptiveness of the mark.

C. THE PROPOSED MARK REMAINS PRIMARILY GEOGRAPHICALLY
DESCRIPTIVE UNDER TRADEMARK ACT SECTION 2(e)(2) BECAUSE THE
APPLICANT'S ARGUMENTS ARE NOT PERSUASIVE

1. The Stylization of the Proposed Mark is not Inherently
Distinctive.

Applicant argues that the stylization of the proposed mark is distinctive and thus, the mark should register. The stylization is however not distinctive because the mark is merely presented in block colored letters. The proposed mark's stylized display does not avoid the geographic descriptiveness refusal because the common block letters are not inherently distinctive. The law is clear with respect to the registration of geographically descriptive terms which are presented in a stylized display. In order for such a mark to be registrable, the features of the display must be of such a nature that they inherently serve

to distinguish the mark in its entirety (or alternatively have achieved acquired distinctiveness). Even in such a case, the merely descriptive components of the mark (or generic components if under Trademark Act Section 2(f)) must be disclaimed apart from the mark under Section 6(a) of the Trademark Act. See, *In re Geo A. Hormel & Company* 227 USPQ 813 (TTAB 1985); *In re Miller Brewing Co.*, 226 USPQ 666 (TTAB 1985). The applicant has not disclaimed all of the words in the mark, thus applicant's reliance on the stylization carrying the mark is not entirely understood. The TTAB has held that "a display of descriptive, generic or otherwise unregistrable matter is not registrable on the Principal Register unless the stylization of the words or the accompanying design features of the asserted mark create an impression on purchasers separate and apart from the impression made by the words themselves, or unless it can be shown by evidence that the particular display which applicant uses has acquired distinctiveness." *In re The American Academy of Facial Plastic and Reconstructive Surgery*, ___ USPQ2d ___ Serial No. 75/215,519 (TTAB May 30, 2002); see also, *In re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1216 (TTAB 1998) (green background tag for clothing); *In re Anton/Bauer Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988) (parallelogram used as background design for applicant's housemark, the words ANTON/BAUER); and *In re Miller Brewing Company*, 226 USPQ 666, 668 (TTAB 1985)(display of "Lite" for beer held registrable on the basis of acquired distinctiveness).

In this case, the applicant has presented the mark in common capital letters with bolded periods. There is "nothing unusual or even different in the formation of the letters" which would make them inherently distinctive. *In re Pollio Dairy Products*

Corp., 8 USPQ 2012 (TTAB 1988). Because the stylization is not inherently distinctive, the mark remains geographically descriptive under Trademark Act Section 2(e)(2).

2. Colors as Part of Stylization are not Inherently
Distinctive.

The applicant also argues that the proposed mark should register because the multiple colors in the proposed mark render it distinctive. However, the Supreme Court has determined that multiple color marks are never inherently distinctive, and cannot be registered on the Principal Register without a showing of acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000); *see also, Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 162-163, (1995)). *See* TMEP §1202.05(a) and cases cited therein. Because neither the stylization, nor the color of the proposed mark make it inherently distinctive, the mark remains geographically descriptive under Trademark Act Section 2(e)(2).

3. Applicant's Arguments and Reliance on Third Party
Registrations is Misplaced.

Applicant argues that because other registrations with city names have registered, the current application should be allowed. However, previous decisions of examiners allowing other marks are without evidentiary value and are not binding upon the agency or the Board. "*Each case must be decided on its own merits.*" *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 639 (TTAB 1984). Furthermore, the registrations noted by the applicant, are all registered with disclaimers of the city name, or are based on Trademark Act Section 2(f). Thus, even if the examining attorney considered the third

party registered marks, the marks are irrelevant because the city names are disclaimed as geographically descriptive or, have acquired distinctiveness.

4. Applicant's Arguments Regarding its Registered and approved Co-pending marks are not Persuasive because the Marks at Issue are Different.

Finally, the applicant argues that because it owns Registration No. 2418035 for the mark "N.Y.C. NEW YORK COLOR," and Serial No. 75/866877 for "N.Y.C. NEW YORK COLOR" which has been published and has received a notice of allowance, the proposed mark should register. However, the above listed registration and application both disclaim the term "N.Y.C. NEW YORK," and contain the merely suggestive term "COLOR." The current mark "N.Y.C. NEW YORK EYEWEAR" does not contain a suggestive term in addition to the geographically descriptive matter, but the highly descriptive or generic term, "EYEWEAR." Thus, in the case at hand, a finding of geographic descriptiveness is unavoidable.

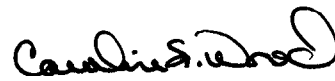
D. SUMMARY

Because the applicant's mark, N.Y.C. NEW YORK EYEWEAR contains the name of a place known to the public, N.Y.C. NEW YORK; the other term in the mark, EYEWEAR, is generic; and the goods are manufactured produced or originate in or near N.Y.C. NEW YORK, the mark is primarily geographically descriptive.

III. CONCLUSION

For the foregoing reasons, the refusal to register the mark under Section 2(e)(2) of the Trademark Act should be affirmed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Caroline E. Wood". The signature is fluid and cursive, with the first name "Caroline" being more prominent than the last name "Wood".

Caroline E. Wood
Trademark Attorney

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